

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH S. HOFFMAN

Appeal No. 98-0059
Application 08/540,548¹

ON BRIEF

Before ABRAMS, STAAB, and CRAWFORD, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the decision of the examiner
finally rejecting claims 1-5 and 7-10, which at that point

¹ Application for patent filed October 6, 1995.

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constituted all of the claims of record in the application.²

An amendment after the final rejection was entered (Paper No. 10), which alleviated a rejection under 35 U.S.C. § 112, first paragraph, but did not overcome the standing rejection of all pending claims under 35 U.S.C. § 103.

The appellant's invention is directed to a roof flashing strip. The subject matter before us on appeal is illustrated by reference to claim 1, which reads as follows:

1. A prefabricated flashing strip system for weatherproofing intersection of upright wall and a shingled roof, the system comprising:

a plurality of partially overlapping adjacently disposed flashing cards, each of the plurality of partially overlapping adjacently disposed flashing cards having a substantially vertical portion and a substantially horizontal portion.

a sealing, watertight adhesive interposed between adjacent flashing cards for sealably mounting the vertical portion of each of the plurality of partially overlapping adjacently disposed flashing cards to the vertical portion of an adjacent flashing card, forming a substantially watertight seal therebetween; and

wherein a shingle is slidably seated between the substantially horizontal portion of each of the plurality of partially overlapping adjacently disposed flashing cards.

² Paper No. 8, the final rejection, erroneously indicated that claim 6 was still of record, although it had been canceled in the amendment designated as Paper No. 7.

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THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Prestidge	4,594,818	Jun. 17, 1986
Hartman	5,337,526	Aug. 16, 1994
Damron	5,381,632	Jan. 17, 1995

THE REJECTION

Claims 1-5 and 7-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hartman or Prestidge in view of Damron.

The rejection is explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief and the Reply Brief.

OPINION

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claims, the prior art applied against the claims, and the respective views of the examiner and the appellant as set forth in the Answer and the Briefs. As a result of our review, we have determined that the rejection should not be sustained. Our reasoning in support of this conclusion follows.

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The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988). The appellant's invention provides that a plurality of flashing cards be attached together into a flashing strip. The flashing cards overlap with one another, and are attached together by, in the language of claim 1,

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a sealing, watertight adhesive interposed between adjacent flashing cards for sealably mounting the vertical portion of each of the plurality of partially overlapping adjacently disposed flashing cards to the vertical portion of an adjacent flashing card, forming a substantially watertight seal therebetween.

According to the appellant, the sealing, watertight adhesive performs two functions. First, it attaches together a plurality of flashing cards and therefore makes flashing easier for the installer to use. Second, it guards against water seepage between individual flashing cards, thus improving the roofing. See specification, pages 7 and 8.

The examiner finds in both Hartman and Prestidge all of the subject matter required by claim 1 except for the "sealable means between the overlapped vertical portions of adjacent shingles [*sic*, cards]" (Answer, page 2). It is the examiner's position, however, that Damron teaches placing sealing between two vertical members to exclude water, and therefore it would have been obvious to place sealant "between any structures where sealant is called for" (Answer, page 2). The examiner also points out that his dictionary defines sealant as "an adhesive agent used to secure something or to prevent the seepage of moisture or air," and therefore the

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sealant meets the adhesive requirement of the claim also
(Answer, page 4).

We cannot subscribe to the examiner's reasoning. Claim 1 requires that there be a "sealing, watertight adhesive" for "sealably mounting" the vertical portions of the overlapping cards together to form a "substantially watertight seal therebetween." As far as the primary references are concerned, Prestidge discloses neither an adhesive nor a sealant, so it lacks an element having either of the required properties, and Hartman discloses only an adhesive, because no sealing is required, and therefore it lacks one of the required properties. The secondary reference, Damron, discloses a sealant with no adhesive properties, for no adhesive is necessary. Moreover, none of the applied references recognizes the problem to which the appellant has directed his inventive efforts. Thus, from our perspective, applying the teachings of Damon to either of the primary references would, at best, result in the application of a bead of sealant to the upper edge of the flashing, rather than the application of a sealing watertight adhesive between the vertical portions of adjacent overlapping flashing cards.

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In the final analysis, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to combine the references in such a manner as to meet the terms of claim 1, other than the hindsight accorded one who first viewed the appellant's disclosure. This, of course, is impermissible as the basis for a rejection. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Such being the case, the teachings of the references fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in independent claim 1 or, it follows, of any of the other claims, all of which are dependent from claim 1.

The rejection is not sustained.

The decision of the examiner is reversed.

REVERSED

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	Administrative Patent Judge)	
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